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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/567,808	06/18/2007	Albert J. Wong	37075-0136-00-US	1219

23973 7590 07/09/2010

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EXAMINER

WILDER, CYNTHIA B

ART UNIT

PAPER NUMBER

1637

NOTIFICATION DATE

DELIVERY MODE

07/09/2010

ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/567,808

Applicant(s)

WONG, ALBERT J.

Examiner

CYNTHIA B. WILDER

Art Unit

1637

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 April 2010.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1-40 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☒ The drawing(s) filed on 08 February 2006 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SI.08)
Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

DETAILED ACTION

1. Applicant's amendment filed 4/13/2010 is acknowledged and has been entered. Claims 1, 5, 20-22, 26-28, 34, 37-38 and 40 have been amended. Claims 1-40 have been pending. All of the arguments have been thoroughly reviewed and considered but are deemed moot in view of the new grounds of rejections necessitated by applicant's amendment of the claims.. Any rejection not reiterated in this action has been withdrawn as being obviated by the amendment of the claims.

This action is made FINAL.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Previous Rejections

3. The objection to the drawings is maintained and discussed below. The objection to the claims is withdrawn in view of Applicant's amendment to the claims. The claim rejection under 35 USC 112 second paragraph is withdrawn in view of Applicant's amendment of the claims. The prior art rejection under 35 USC 103(a) is withdrawn in view of Applicant's amendment of the claims.

Drawings

4. The drawings filed 2/8/2006 are acknowledged. However, Figure 7 is finally objected to because the drawing is difficult to read, perhaps due to copy machine artifacts in that the shading makes interpretation difficult. Applicant is required to submit a proposed drawing correction in reply to this Office action for the Figure 7.

Since Applicant did not address this objection, the above objection is maintained.

New Ground(s) of Rejections

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

(a) Claims 1-40 are indefinite and confusing in the claim 1 at the steps (f) through (h) because it unclear how the coupling step operates in order to identify alternative spliced RNA. For example, it cannot be determined if Applicant is suggesting that the coupling step (f) is intended to encompass ligation between the two single strand ends of every cross-hybridized double stranded cDNA from step (e) such that loops are formed or if Applicant is suggested that the ends of each of the selected cross-hybridized double stranded cDNAs from step (e) are coupled (ligated) to each other or something entirely different. Additionally, the coupling step is confusing in the last two lines of step (f) because if double stranded cDNA is denatured (even after being

coupled or ligated) it would be obvious that single stranded nucleic acid molecules are formed. Therefore, a clear interpretation of Applicant's intent cannot be ascertained.

(b) Claims 1-40 lacks proper antecedent basis for "the region of the sequences" because no "regions" have previously been identified and thus it cannot be determined what Applicant is making reference to.

Conclusion

7. No claims are allowed. However, the claims have not been rejected under prior art because no prior art was found teaching the combination of method steps wherein selectable tags are used in combination with cross hybridization of double stranded cDNA for detecting alternatively spliced RNA molecules from different populations.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to CYNTHIA B. WILDER whose telephone number is (571)272-0791. The examiner can normally be reached on a flexible schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary Benzion can be reached on (571) 272-0782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/GARY BENZION/
Supervisory Patent Examiner, Art Unit 1637